

### **REMARKS**

Claims 1-41 are currently pending in the subject application and are presently under consideration. The specification has been amended as shown on p. 2 of the Reply. Claims 1, 3, 7, 16-19, 27-32 and 39 have been amended as shown at pp. 3-7 of the Reply. Non-elected claims 41-111 have been cancelled. Applicant reserves the right to prosecute these non-elected claims in one or more subsequently-filed divisional applications.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

#### **I. Objection to the Drawings**

An objection has been made to Figs. 3 and 7. Corrected drawings are submitted herewith. No new matter is presented. Withdrawal of this objection is respectfully requested.

#### **II. Objection to the Specification**

An objection has been made in relation to an informality in the disclosure. Correction is made with the subject amendment. No new matter is presented. Withdrawal of this objection is respectfully requested.

#### **III. Objection to the Claims**

An objection has been made to various claims. Correction to a number of these objections is made with the subject amendment. No new matter is presented. However, one ground of objection was that the claims require “wherein.” It is respectfully submitted that there is no legal basis for requiring that the term “wherein” be included in a claim. In view of least the above, withdrawal of this objection is respectfully requested.

#### **IV. Rejection of Claims 7 and 39 Under 35 U.S.C. §112**

Claims 7 and 39 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. This rejection should be withdrawn for the following reasons. The Office Action contends that the claims recite terms not disclosed in the disclosure. The claims have been amended to remove the objected terms. Therefore, this rejection should be withdrawn.

**V. Rejection of Claims 1-6, 8-18, 22-35 and 40 Under 35 U.S.C. §102(e)**

Claims 1-6, 8-18, 22-35 and 40 stand rejected under 35 U.S.C. §102(e) as being anticipated by Van Erlach (US 2004/0204063). This rejection should be withdrawn for the following reasons. Van Erlach does not disclose or suggest each and every limitation set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it ***expressly or inherently describes each and every limitation set forth in the patent claim.*** *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The ***identical invention must be shown in as complete detail as is contained in the ... claim.*** *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Applicants' claimed invention relates to an ***m-commerce system***, comprising ***a data input component that receives item data representative of an article of commerce, a coordination component that presents the article of commerce to a vendor for bid, a location awareness component that tracks the location of the data input component, and a payment component that facilitates payment of the article of commerce.*** Van Erlach does not disclose or suggest these novel aspects of the invention as claimed.

Van Erlach relates to methods and platforms for providing "enhanced telecommunication services," *i.e.* wireless communication devices having enhanced technological functions, for data-intensive wireless content transmission. Contrary to assertions in the Office Action, Van Erlach does not disclose or suggest the claimed invention, in the cited paragraphs let alone anywhere else in the cited document. Van Erlach discloses various distinct embodiments, and the Office Action cites elements from each against the claimed invention. Paragraphs [0016] and [0017] are respectively cited against the claimed *location awareness component* and the *payment component*. However, paragraph [0016] actually discloses a means of wireless vital sign and location monitoring, for tracking parameters such as body temperature or distance from a specified location for a subject, and sending a message in the event the parameter is violated. Clearly no m-commerce or the like can be inferred from this distinct embodiment. Paragraph [0017] discloses another distinct embodiment of creating and maintaining an "event futures

market," similar to a stock market, in which subscribers enter estimates of the outcome of a future event. No m-commerce aspects are disclosed in this distinct embodiment either.

Paragraph [0032] is cited against the claimed *coordination component*. This paragraph discloses an "Entertainment Event Futures Determination Service" in which the outcome of future events is determined, such as sales of DVDs, games, books, *etc.* A "securities trading marketplace" is created where potential sales of products are traded like stocks in which "buyers and sellers bid to determine its value and exchange a unit of value which may be monetary or otherwise."

Clearly, these diverse and unrelated embodiments are very different from each other and also the claimed *coordination component that presents the article of commerce to a vendor for bid*. In view of at least the above, it readily apparent that the various elements cited against the aspects of claim 1 are drawn from very different embodiments. It is therefore clear that the disclosure of Van Erlach, taken as a whole, does not disclose or suggest the *m-commerce system* as recited in claim 1. There would be no motivation to make a piecemeal selection from each of Van Erlach's embodiments, and such would not occur to a person having skill in the art unless guided by the subject disclosure as a 20/20 hindsight roadmap to the claimed invention. For at least the above reasons, the rejection of independent claim 1 (and claims that depend there from) should be withdrawn.

#### **VI. Rejection of Claim 7 Under 35 U.S.C. §103(a)**

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Van Erlach in view of Gellman (US 2002/0035536). Withdrawal of this rejection is requested for at least the following reasons. Claim 7 depends from independent claim 1. As stated *supra*, Van Erlach does not disclose or suggest every limitation set forth in the subject independent claim. Gellman does not cure the aforementioned deficiencies of the primary reference. Withdrawal of this rejection is therefore respectfully requested.

#### **VII. Rejection of Claims 19-21 Under 35 U.S.C. §103(a)**

Claims 19-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Van Erlach in view of Freund (US 2003/0187787). Withdrawal of this rejection is requested for at least the following reasons. As stated *supra*, Van Erlach does not disclose or suggest every limitation set forth in independent claim 1, and Freund does not cure the aforementioned

deficiencies. Therefore, claims 19-21, which depend there from, are allowable for at least the same reasons. Withdrawal of this rejection is therefore respectfully requested.

**VIII. Rejection of Claims 36-37 Under 35 U.S.C. §103(a)**

Claims 36-37 stand rejected under 35 U.S.C. §103(a) as being unpatentable Van Erlach in view of Edgett *et al.* (US 2004/0034771). Withdrawal of this rejection is requested for at least the following reasons. Claims 36 and 37 depend from independent claim 1. As stated *supra*, Van Erlach does not disclose or suggest every limitation set forth in the subject independent claim. Edgett *et al.* does not cure the aforementioned deficiencies of Van Erlach. Therefore, this rejection should be withdrawn.

**IX. Rejection of Claim 38 Under 35 U.S.C. §103(a)**

Claim 38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Van Erlach in view of Grunes *et al.* (US 2002/0113707). Withdrawal of this rejection is requested for at least the following reasons. Claim 38 depends from independent claim 1. As noted *supra*, Van Erlach does not disclose or suggest every limitation set forth in the subject independent claim. Grunes *et al.* does not make up for the deficiencies of the cited reference. For at least these reasons, this rejection should be withdrawn.

**X. Rejection of Claim 39 Under 35 U.S.C. §103(a)**

Claim 39 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Van Erlach in view of Hoffberg (US 6,791,472). Withdrawal of this rejection is requested for at least the following reasons. Claim 39 depends from independent claim 1. Van Erlach does not disclose or suggest every limitation set forth in the subject independent claim, as stated *supra*. Hoffberg fails to cure the aforementioned deficiencies, therefore this rejection should be withdrawn.

**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [SYMBP152US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN, TUROCY & CALVIN, LLP

/Himanshu S. Amin/

Himanshu S. Amin

Reg. No. 40,894

AMIN, TUROCY & CALVIN, LLP  
24<sup>TH</sup> Floor, National City Center  
1900 E. 9<sup>TH</sup> Street  
Cleveland, Ohio 44114  
Telephone (216) 696-8730  
Facsimile (216) 696-8731